



FEB 21 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Michael G. Gilman
LOWE HAUPTMAN GOPSTEIN GILMAN & BERNER LLP
1700 Diagonal Road, Suite 310
Alexandria, Virginia 22314

In re Application of	:	
HERRINGTON, John F.	:	
Application No.: 09/626,886	:	DECISION ON PETITION
Filing Date: 27 July 2000	:	
Attorney Docket No.: 4394-002PCT	:	
For: RIBBED CORDED DUAL WALL	:	
STRUCTURE	:	

This is a decision on applicant's "PETITION TO REVIVE" filed 27 July 2000 in the above-captioned application.

BACKGROUND

On 29 July 1999, applicants filed international application No. PCT/US99/17172 which claimed a priority date of 12 August 1998, and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand was not filed with the International Preliminary Examining Authority electing the United States prior to the expiration of 19 months from the priority date, and as a result the deadline for submission of a copy of the international application and payment of the basic national fee was to expire 20 months from the priority date, i.e. **12 April 2000**.

On 27 July 2000, applicants filed the present petition accompanied by transmittal document, an executed declaration, a declaration of small entity status, and a check for \$381.00. The petition requests:

- (1) "withdrawal of the claim for priority from US provisional application 60/096,237 and recalculation of the due date for filing the Demand;
- (2) if relief 1 is denied, revival of the instant application on the basis that its abandonment was unavoidable;
- (3) if relief 1 and 2 are denied, revival of the instant application on the basis that its abandonment was unintentional."

Applicant's request for the withdrawal of the claim for priority from US provisional application 60/096,237 and recalculation of the due date for filing the Demand has been addressed with Form PCT/RO/132. Applicant's request was REFUSED.

DISCUSSION

International application PCT/US99/17172 became abandoned as to the United States of America at midnight on 12 April 2000 for failure to pay the basic national fee.

A. Conflict In Filing Instructions

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.494(f):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-114 of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On 27 July 2000, applicant submitted a transmittal letter entitled "Utility Patent Application Under 37 CFR 1.53(b)." The submission of a transmittal letter for a "Utility Patent Application Under 37 CFR 1.53(b)" is inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371. Accordingly, the original papers deposited on 27 July 2000 will be treated as a filing under 35 U.S.C. 111(a).

B. Petition under 37 CFR 1.137(a)

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicant has satisfied Item (1), (2) and (4).

With regard to Item (1), the proper response is the payment of the basic national fee of \$345.00.

As to Item (2), the appropriate petition fee of \$55.00 is required pursuant to 37 CFR 1.17(m).

With regard to Item (3), Section 711.03(c) of the Manual of Patent Examining Procedure states: "A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (A) the error was the cause of the delay at issue; (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee was sufficiently trained and experienced with

regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.”

The petitioner states that, “[i]t is hereby petitioned to revive the PCT application because missing the Demand due date was inadvertent and unavoidable. Missing this date was due to a docketing error as to the priority date that was being claimed. Once the error was made as of the initial filing of this PCT application, the error of filing the Demand 18 days late could not have been avoided. It is therefore urged that this application be revived on the basis that its abandonment was avoidable.” However, petitioner has not provided sufficient evidence that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance and that the employee(s) was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In summary, the actions taken in the prosecution of this case do not reflect unavoidable delay. Specifically, unavoidable delay is present only where petitioner and those acting for petitioner take all actions necessary to continue the prosecution of an application, but through the intervention of unforeseen circumstances, a required action is not timely taken. The actions and circumstances described in this petition; however, do not reflect the “care or diligence that is generally used and observed by prudent and careful men in relation to their most important business.” Ex parte Pratt, 1887 Dec. Comm’r Pat. 31 (Comm’r Pat. 1887).

Therefore, applicant has not satisfied item (3) above.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(a), revival under this section would not be proper.

C. Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the “entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional,” and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the payment of the basic fee of \$345.00.

As to Item (2), the appropriate petition fee of \$620.00 has been submitted.

With regard to Item (3), applicant’s statement that “it is hereby petitioned to revive this application because its abandonment was unintentional” does not comply with 37 CFR 1.137(b)(3). However, the statement will be accepted and construed as meaning that “entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional.” If this is an incorrect interpretation in view of the rules, Petitioner is required to provide a statement to that effect.

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

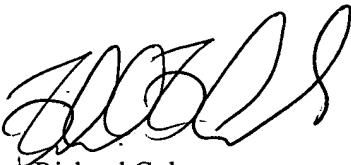
CONCLUSION

For the reasons discussed above, applicant's petition to revive international application PCT/US99/17172 is **GRANTED**.

International application PCT/US99/17172 is being revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the continuing application number 09/626,886. A copy of this decision will be placed in international application no. PCT/US99/17172.

International application no. PCT/US99/17172 will be returned to the PTO's abandoned files repository.

The present application will then be forwarded to Art Unit 3653 for examination in due course.



Richard Cole
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459